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10/716,197	11/17/2003	John Phillips	91489 MGB	4122

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EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/716,197	PHILLIPS ET AL.
	Examiner	**Art Unit**	
	John M. Winter	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 September 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>49-87</u> is/are pending in the application.

    4a) Of the above claim(s) <u>54,61-63 and 65</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>49-53,55-60,64 and 66-87</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 49-53, 55-60, 64 and 66-87 are drawn towards usage protection of distributed files, classified in class 705 subclass 51.

II. Claims 54 is drawn is drawn towards usage protection of distributed files, classified in class 705 subclass 51.

III. Claims 61-63 are drawn to a usage protection of distributed files, classified in class 705 subclass 51.

IV. Claim 65 is drawn to a usage protection of distributed files, classified in class 705 subclass 51.

Inventions I - IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the

subcombination as claimed in inventions II - IV such as a searching method (II), a digest (III), or utilizing E-mail (IV).

Examiner notes that is would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on September 5, 2007 a provisional election was made without traverse to prosecute the of Invention I, claims 49-53, 55-60, 64 and 66-87. Affirmation of this election must be made by applicant in replying to this Office action. Claims 54, 61-63 and 65 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 49-53, 55-60, 64, and 66-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (US Patent 5,805,699) over Cooper et al. (US Patent 5,563,946)

As per claim 49

Akiyama et al. discloses a method for sharing data with one or more recipients, the method comprising:

creating and storing a bundle containing information about the selection of data in a location accessible by a bundle server; associating bundle identification information with the bundle; creating a token representing the bundle, the token including the bundle identification information; (Column 3, lines 41-50)

providing the token to a recipient; establishing communication between the recipient and the bundle server: receiving a request for the bundle from the recipient, the request comprising, at least in part, the bundle identification information from the token; and providing a copy of the bundle to the recipient having the token; (Column 4, lines 4-24)

Akiyama et al. does not explicitly disclose identifying a selection of data to be shared. Cooper et al. discloses identifying a selection of data to be shared (Figure 8) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Akiyama et al.'s method with Cooper et al.'s teaching in order to allow related software products to be purchased and licensed together

Akiyama does not specifically disclose "wherein the bundle identification information comprises: a bundle identifier comprising a value generated randomly within a range of one million or more possible values; a bundle store identifier comprising a value generated randomly within a range of one million or more possible values; and an encrypted bundle name, corresponding to a bundle name associated with the bundle, the encrypted bundle name generated using the bundle store private key"

Official Notice is taken that "a bundle identifier comprising a value generated randomly within a range of one million or more possible values; a bundle store identifier comprising a value generated randomly within a range of one million or more possible values; and an encrypted bundle name, corresponding to a bundle name associated with the bundle, the encrypted bundle name generated using the bundle store private key" is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to randomly nme an identifier in order to prevent predictive spoofing of the transaction system.

Claims 16, 29, 41 and 43 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 50

Akiyama et al. discloses a method according to claim 49,

wherein creating the bundle comprises storing the bundle in a bundle store, the bundle store associated with a bundle store sharer identity, the bundle store sharer identity being unique among a plurality of bundle store sharer identities corresponding to a plurality of bundle stores accessible to the bundle server, the bundle store containing one or more bundles, corresponding to a sharer, the sharer having a sharer identity, matching the bundle store sharer identity (Column 4, lines 4-23).

As per claim 51,

Akiyama et al. discloses a method according to claim 50,

wherein the bundle store is associated with a bundle store key pair generated by an

asymmetric encryption system, the key pair including a bundle store public key and a bundle

store private key and wherein creating the token comprises including the bundle store public key

in the token (Figure 6).

As per claim 56,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose "incrementing the retrieval count each time a

copy of the bundle is provided to a recipient"

Official Notice is taken that "incrementing the retrieval count each time a copy of the

bundle is provided to a recipient" is common and well known in prior art in reference to

electronic transactions. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to increment a copy count in order to ensure that a users license

count has not been exceeded.

As per claim 59,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose "obtaining a current date, and, communicating

with the bundle server only if the expiry date is later than the current date"

Official Notice is taken that "obtaining a current date, and, communicating with the bundle

server only if the expiry date is later than the current date" is common and well known in prior

art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilze a date in orderr to ensure that the client hasa valid license.

As per claim 67,

Akiyama et al. discloses a method according to claim 66,

comprising delivering said bundle when said testing determines that said communication includes said bundler identifier(Column 3, lines 41-65).

As per claim 68,

Akiyama et al. discloses a method according to claim 67,

wherein said receiving is from said recipient computer system and said delivering is to said recipient computer system (Figure 4) .

As per claim 69,

Akiyama et al. discloses a method according to claim 68,

wherein said bundle server comprises another computer system separate from said sharer computer system and said recipient computer system, said bundle server includes said bundle store, and said creating further comprises sending said files and/or folders to said bundle Server (Figure 4).

As per claim 70,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose "providing said token as an attachment to an e-mail communication"

Official Notice is taken that "providing said token as an attachment to an e-mail communication" is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utlize email to send a token because this is an inexpensive and reliable manner to deliver information.

As per claim 71,

Akiyama et al. discloses a method according to claim 66,

wherein said bundle server comprises another computer system separate from said sharer computer system and said recipient computer system, said bundle server includes said bundle store, and said creating further comprises sending said files and/or folders to said bundle server (Figure 4).

As per claim 72,

Akiyama et al. discloses a method according to claim 66,

further comprising maintaining a record of contents of said delivered bundle (Column 3, lines 41-65).

As per claim 73,

Akiyama et al. discloses a method according to claim 66,

further comprising maintaining a copy of said bundle following said delivering (Column 3, lines 41-65).

As per claim 74,

Akiyama et al. discloses a method according to claim 66,

wherein said generating further comprises deriving contextual information about said selection of files and adding said contextual information to said token (Column 4, lines 25-42).

As per claim 75,

Akiyama et al. discloses a method according to claim 74

wherein said contextual information includes a digest of said bundle (Column 4, lines 25-42).

As per claim 76,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose "following said generating of said token and prior to said sending of said token, allowing the sharer to alter said bundle in said bundle store"

Official Notice is taken that "following said generating of said token and prior to said sending of said token, allowing the sharer to alter said bundle in said bundle store" is common and well known in prior art in reference to electronic transactions. It would have been obvious to

one having ordinary skill in the art at the time the invention was made to alter a bundle prior to

shipping in order to allow a consumer to change or update an order.

As per claim 77,

Akiyama et al. discloses a method according to claim 66

further comprising sending said token to a plurality of additional recipient computer

systems, repeating said receiving, testing, and delivering at least once (Column 4, lines 4-23).

As per claims 78-82

Akiyama et al. discloses a method according to claim 66

Official Notice is taken that "maintaining a ratio of a number of the possible values to a

number of bundles in the bundle store to be at least $10^{20} : 1$" etc... is common and well known

in prior art in reference to databases. It would have been obvious to one having ordinary skill in

the art at the time the invention was made that a value would have a high ratio of values v/s

possible values in order to populate a database without danger of key duplication. A database

that use a license number 20 or 15 digits in length as a key would easily maintain this ratio, also

a large license would be nearly impossible to "guess" (i.e. brute force crack) and ould therefore

meet the limitations of claim 12 as well

As per claim 83,

Akiyama et al. discloses a method according to claim 66

wherein said bundle store is associated with a bundle store key pair generated by an

asymmetric encryption system, said key pair including a bundle store public key and a bundle

store private key, and wherein said generating further comprises including said bundle store

public key in said token (Figure 6).

As per claim 84,

Akiyama et al. discloses a method according to claim 83

receiving one or more communications at said bundle server, said communications

encrypted with said bundle store public key; and

sending one or more other communications from the bundle server, said communications

encrypted with said bundle store private key (Figure 6).

As per claim 85,

Akiyama et al. discloses a method according to claim 83

wherein said token includes an encrypted bundle name, corresponding to a bundle name

associated with the bundle, the encrypted bundle name generated using the bundle store private

key (Figure 6).

As per claim 86,

Akiyama et al. discloses a method according to claim 66 further comprising:

receiving a pass-phrase from a user of said sharer computer

system: and prior to said sending, encrypting said token wherein said token can be decrypted

with use of said pass-phrase (Figure 6).

As per claim 86,

Akiyama et al. discloses a method according to claim 66 further comprising:

creating a bundle key; encrypting at least a part of said bundle using said bundle key; and, storing

said bundle key in said token (Figure 6).

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot

in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The

examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter
Examiner 3621

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